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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,288	02/17/2000	Jin-Su Park	P51671RE	7560

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Robert E. Bushnell and Law Firm  
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Washington, DC 20005-1202

EXAMINER

ISSING, GREGORY C

ART UNIT	PAPER NUMBER
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3662

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/506,288

Applicant(s)

PARK, JIN-SU

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 35-59 is/are rejected.
- 7) ☒ Claim(s) 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The applicant's statements of the status of the claims are not clearly presented. In the claim amendments, the applicant states that claims 4-6 are amended (page 2 of Amdt filed 8/24/06). In the Remarks section of the response (page 34 of the Amdt filed 8/24/06) the applicant states that claims 1-19, 21-43 and 59 are amended. Thus, the status of the claims is not clearly set forth.

2. The response fails to clearly provide an explanation of the support in the disclosure of the patent for each of the changes made to the claims

In the Remarks (page 34), the applicant alleges "each of claims 1 through lies in the disclosure of these claims themselves". The applicant fails to clearly identify which claims he is talking about.

In the remarks section III-B, the applicant alleges that claims 1-59 have been pending since the close of prosecution on the 9<sup>th</sup> of July 2002 and no other amendments have been made; according to the applicant, the original application is not an amendment under 37 CFR 1.121(b)(2)(C)(iii) or 1.173(c) and thus, the applicant is not required to provide an explanation of support. This is contradictory to the statements of the applicant who states that the claims are amended and it is not a proper interpretation of the rule since in a reissue application, any change to the patented claims, represents an amendment to the application and requires an explanation.

Applicant's assertion that on page 34 of the response filed 11/6/02, there is provided support for amendments to claim 1 is not persuasive and does not provide any showing of support for the amendments regarding changes of plural to singular signals, or to the addition of the language "do not" regarding the matching of code sequences.

Applicant's assertion that the support for the changes to claims 4, 5, and 6 lies in the original text of patented claims 4, 5, and 6 is not persuasive since each of the patented claims simply refers to the use of a "video tape recorder . . . for reproducing a video tape".

3. The applicant's assertion that the changes presented by all of the claims 9-59 lie in Figures 1, 3A and 3B in combination with Figures 1 and 4 and col. 1, lines 16-17, col. 2, lines 20-34 and col. 3, line 51 through col. 6, line 2 is not persuasive and such indication of practically the entire specification including the drawings, does not meet the requirement of providing an explanation of the support in the disclosure

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as required by 37 CFR 1.173. Thus, the applicant continues to fail provide explanation of support for the claim changes.

4. For example, in claims 9 and 15, it is not seen where in the specification there is support for the language "controlling production of video images corresponding to said video components through generation of a control output for a period of time defined by a first input of lock key data followed by a secret code and a second input of said lock key data followed by said secret code." Applicant is required to show by column and line number in the original specification where there is support for such feature.

5. For example, in claim 20, it is not seen where in the specification there is support for a "process for operating a video system comprising making a subjective evaluation of content portrayed by a first video signal to be transmitted for reception by a video display apparatus . . . during a system power standby mode of operation selectively generating a code in dependence upon said evaluation and responding to said code by barring transmission of said first video signal to said video display apparatus." Applicant is required to show where in the specification, by column and line number, where this process is specifically supported.

6. In Section IV of the Applicant's remarks, applicant does not address an Office Action rejection or Objection and merely expresses opinions of the applicant.

7. In Section V, the withdrawal of the restriction requirement is noted.

#### **Double Patenting**

##### **35 USC 101 Statutory**

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1-3, 8, 21-24, 27, 28, and 59 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3, 8, 20-23, 26, 27, and 43 of copending Application No.

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10/337364. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

10. In Section VI, A, the applicant alleges that the rejection under 35 USC 101 is moot since the claims have been correspondingly broadened. Applicant's arguments are not convincing and fail to provide any evidence of the differences in scope between the two applications. Applicant's assertion that a Terminal Disclaimer will be filed at the completion of the review of the instant application is not persuasive since a rejection under 35 USC 101 for claiming the same invention cannot be overcome by a Terminal Disclaimer. If applicant maintains the argument regarding differences in scope he is required to specifically point to the claim language providing such distinctions between the two applications.

#### Non-Statutory

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 4-7, 9-19, 25, 26, and 35-43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-6 of copending Application No. 10/337,364. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 4-6 of the instant application is generic to claims 4-6 of the co-pending application and fully encompasses the scope of the co-pending claims and therefore anticipates the copending claims. Additionally, the claims are not distinct from claims 9-19, 24, 25, 34-42 of the copending application since the step of "selectively input from a keyboard or a remote control receiver" is obvious in light of "selectively input by a user of the video system" since the input by a keyboard necessitates the

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input of a user and there is no patentable distinction between “a microprocessor based controller” and “ a microcomputer.”

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The applicant has not provided any recitation of the distinction between the sets of claims in the instant application and the co-pending application. In Section VI, B, applicant states that a Terminal Disclaimer will be filed at the conclusion of review of the instant application to overcome the non-statutory double-patenting rejection.

**35 USC 112, first paragraph**

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Enablement Requirement**

14. Claims 20 and 44-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejections are set forth in paragraphs 15-19 of the previous Office Action.

15. In Section X, C., of the applicant's response, the applicant argues inconclusively for overcoming the rejection under 35 USC 112, first paragraph, with respect to the enablement requirement.

16. With respect to claim 20, the applicant's argument that there is nothing in the language of the claims that requires “making a subjective evaluation of the video image” since content extends beyond a “video image” and may have little relevance to what the video image portrays. This argument is not convincing and in contradictory to the claim language which states “making a subjective evaluation of content portrayed by a first video signal”. The applicant's argument that the specification teaches “the main advantage of this invention lies in the fact that it can bar unauthorized people from watching video

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programs" says nothing with respect to an enabling disclosure for "making a subjective evaluation of content portrayed by a first video signal" nor "generating a code in dependence upon said evaluation."

The mere allegation that an advantage may be had from the invention does not fulfill the requirements of 35 USC 112, first paragraph. The applicant's remarks in the section starting "Fourth . . ." fails to provide any showing of the support for an enabling disclosure. The allegation that the issues raised by the Office are baseless is argumentative and fails to cure the deficiencies.

17. With respect to claim 47, the rejection is not overcome as the applicant has failed to show where a teaching is provided in the original specification for comparing an entered secret code to a stored code and subsequently locking audio while releasing muting of the video. The rejection clearly sets forth what the Office deems is not supported, see sentence 2 of paragraph 17 of the last Office Action.

18. With respect to claims 44-58, the applicant's argument that the purported language was not before the Board is incorrect and not germane to the issue. Regarding the applicant's assertion that the use of the adverb "only" is not present in the claims is not germane to the rejection as the Office Action clearly sets forth that it is the view of the Office that the Board decided that the claimed operation was performed during a standby mode and that the claims as presented are not. As the Board's opinion expressed the patentability of the claims over the art in view of the operation during standby and not with respect to operation in a power on mode, the claimed subject matter for operating first and a second lock key operation having video information generated and displayed therebetween is not supported by the specification as originally filed. The applicant's argument that steps 12, 16 and 17 of Figure 1 provide support is not convincing since no second lock key signal operation is shown therein.

Written Description Requirement

19. Claims 20 and 44-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

20. The rejection is set forth in paragraphs 20-23 of the previous Office Action.

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21. With respect to the rejection of claims 20 and 44-58 under 35 USC 112, first paragraph as failing to comply with the written description requirement, the applicant fails to provide any response thereto, simply repeating the Office's rejection in Section X, D. The rejection is therefore maintained.

**35 USC 112, second paragraph**

22. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

23. Claims 47, 50-52 and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

24. The rejection is set forth in paragraphs 24-28 of the previous Office Action.

25. With respect to the rejection of claims 44-58 under 35 USC 112, second paragraph, the applicant's arguments in Section X., E., are considered with the following remarks.

Regarding claim 44, the amendment overcomes the previous rejection.

Regarding claim 47, the applicant provides no response. The rejection is maintained.

Regarding claims 50-52 and 58, the applicant's allegation that the relationship between "the second lock key data" and "reference" is well-defined, precise and inescapable in its meaning and clarity, is unsupported, repetitive, and not convincing. The rejection is maintained.

**35 USC 103**

26. Claims 9-13, 15-19, 24, 25, 29-33, 35-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rew (5,033,085) in view of Inagaki et al (4,896,354).

27. The rejection is substantially set forth in a previous Office Action filed 6/24/05, pages 4-9, and summarized in the last Office Action (2/21/06) in paragraphs 31-32.

28. The rejection of claims 9-13, 15-19, 24, 25, 29-33, and 35-43 under 35 USC 103(a) as being unpatentable over Rew in view of Inagaki et al is maintained as the applicant has not provided any arguments and has merely reiterated the Office's rejections/response from the previous Office Action as



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found in Section F of the Applicant's response. The Office's arguments in the prosecution history are additionally maintained.

**35 USC 251**

29. Claims 20, 44, 45, 47-51 and 54-58 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

30. The rejection regarding claim 20 is set forth in the previous Office Action in paragraphs 42-51 and the rejection regarding claims 44, 45, 47-51 and 54-58 are set forth in paragraphs 53-55 of the previous Office Action.

31. The rejection of claims 20, 44, 45, 47-51 and 54-58 under 35 USC 251 as being improper recapture of broadened claimed subject matter is maintained since the applicant has merely reiterated the Office's opinion from the previous Office Action as found in Sections G and H of the Applicant's response.

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

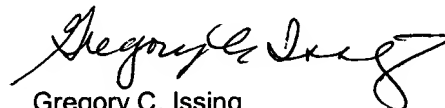
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is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gregory C. Issing  
Primary Examiner  
Art Unit 3662

gci